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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/620,269

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EXAMINER

HENDRICKSON, STUART L

ART UNIT

PAPER NUMBER

1754

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/620,269

Applicant(s)

BHATT, SANDEEP

Examiner

Stuart Hendrickson

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

Art Unit: 1754

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 5, 7-11, 22, 23, 26, 28-30, 34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Van Konynenburg et al. 4775778.

The reference teaches in col. 6 and 13 black Regal 660 having area of 112 and size of 17 nm. Column 6 teaches the overall particle size (325 mesh is 44 micron, so the teaching of 80 nm meets the 325 mesh limitation). The reference does not explicitly teach the claimed iodine number, however the iodine and nitrogen values roughly correspond. Therefore, it appears that the product is the same. A polymer composition having 5-50% carbon black is taught; see col. 8, 15. Concerning claim 22, the ash and sulfur values appear within the range of conventional carbon blacks.

Where the examiner has found substantially the same product as claimed in the art, the burden is upon the applicant to show a difference; In re Fitzgerald et al. 205 USPQ 594.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Konynenburg. The reference does not teach the kind of polyethylene, however teaches the genus. Using the claimed type of PE is an obvious expedient because it meets the requirements of the polymer needed.

Art Unit: 1754

Claims 1-30, 34-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Sant 5877250. The reference teaches what appears to be the claimed carbon black. Specification pg. 13 indicates that the present carbon black is the same as that of Sant, with no modifications made.

Claims 1-30, 34-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Sant 5877251. The reference teaches what appears to be the claimed carbon black. Specification pg. 13 indicates that the present carbon black is the same as that of Sant, with no modifications made.

Claims 1, 4, 7-9, 22, 23, 25, 26, 29, 30 and 34-36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Thielen 5902517 in view of Probst et al. 5639817.

The reference teaches in table 1 ENASCO 250 carbon black having area 65 and low volatiles content (which appears to meet the toluene extractables claimed since both represent low weight organic compounds). Column 1 indicates low primary particle size and a resin is taught (col. 2 line 30). Probst table 2 teaches iodine of 47 ('about 50'), DBP 160, CDBP of 92, and teaches rubber composition. Concerning claim 22, 325 mesh appears met since carbon black as synthesized is a fine powder and the ash, sulfur values appear conventional.

Where the examiner has found substantially the same product as claimed in the art, the burden is upon the applicant to show a difference; *In re Fitzgerald et al.* 205 USPQ 594.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 1754

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-23, 26-30, 34-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 22-53 of U.S. Patent No. 6852790.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim common, overlapping, subject matter in the ranges of values.

The reference elucidates in col. 3 overlapping particle size, and other properties. The polymers are indicated in col. 8.

Claims 1-10, 26, 29-33 and 41 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6482386.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the numerical values overlap.

Column 4 teaches a tube shape and fluffy form, which indicates the 325 mesh limitation is met.

The Industrial Carbon reference is presented as evidence that as-synthesized carbon blacks meet the 325 mesh limitation.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (571) 272-1351.



Stuart Hendrickson  
examiner Art Unit 1754